

REMARKS

Support for the Amendments to the Specification

The replacement paragraph beginning at page 6, line 14, seeks solely to correct a spelling error.

The replacement Table and Legend following beginning on page 11, at line 5, seeks solely to properly set forth certain trademarks and to avoid any improper use of any trademarks.

The replacement Table beginning on page 12, at line 19, seeks solely to properly set forth certain trademarks and to avoid any improper use of any trademarks.

The replacement Table and Legend beginning on page 13, line 27, seeks solely to properly set forth certain trademarks and to avoid any improper use of any trademarks.

The replacement Table and Legend beginning on page 15, at line 1, seeks solely to properly set forth certain trademarks and to avoid any improper use of any trademarks.

Summary of Personal Interview with the Examiner

On March 19, 2004, Examiner Melanie Bissett and the Applicants' Representative, Mr. Andrew Merriam, conducted a personal interview to further prosecution in the instant application. The Applicants wish to thank the Examiner for extending them the courtesy of a personal interview.

In the interview, Mr. Merriam explained the Standard Test Method for Specular Gloss, ASTM D 523-89 (reapproved 1999), which was the method used to measure the gloss of coatings made in each of Examples 1, 2, 3, and 4 in the instant specification. A copy of the ASTM D 523-89 (1999) test was given to the Examiner. Specifically, Mr. Merriam pointed out that the 20° geometry used to make gloss measurements in the Jurgetz et al. reference (U.S. 6,277,917 B1 at col. 16, Table IV, lines 31-35) is advantageous for measuring the gloss of specimens having a 60° gloss of higher than 70, a very high gloss. See ASTM D 523-89 at page 1, 4.1.2. As Mr. Merriam explained, this geometry of gloss measurement makes logical sense: 20° gloss is measured using a beam

April 29, 2004

axis angle of 20° from the perpendicular to the specimen surface, i.e. 20° from perpendicular, and gloss appears minimized when viewed from a perpendicular as opposed to an oblique angle. See ASTM D 523-89 at page 2, 6.2, 6.2.1.1 and Fig. 1 Diagram of Glossmeter. Accordingly, Jurgetz et al. use a high gloss measurement method.

Further, Mr. Merriam explained that Jurgetz et al. desires only high gloss coatings, as opposed to a powder coating composition for providing a low gloss surface finish, as instantly claimed. See col. 16, Table IV, lines 31-33 of Jurgetz et al. in describing 20° gloss measurement: “higher numbers for gloss indicate better performance”. Consistent with high gloss coatings, the Jurgetz et al. teachings re: crystalline crosslinkers (col. 7, lines 23-55, especially at lines 51-55) specifically state that “when the powder coating composition is melted, the polyacid crosslinking agent is compatible and soluble in the acrylic copolymer...allowing for improved “*flow and appearance*.” Accordingly, in improving “flow and appearance” the crosslinkers of Jurgetz et al. increase the gloss of the coating, i.e. its performance improves per Table IV.

In examining the instant claims reciting a powder coating composition for providing a low gloss surface finish, Mr. Merriam explained, the ordinary skilled artisan would look for teachings relating to low gloss coating compositions to supplement the teachings of Kranig et al. Accordingly, the ordinary skilled artisan would look away from the teachings of Jurgetz et al., which teach away from low gloss powder coating compositions.

The Examiner indicated that, in her view, there could be some reason to combine Kranig et al. with Jurgetz et al. In response, Mr. Merriam pointed out that such a combination must address the teachings of each of the references in the context of the instant claims. Thus, because the instant claims recite a powder coating composition for providing a low gloss surface finish, a reference combination may not lead the primary reference, Kranig et al., away from compositions that make low gloss coatings. Otherwise, the combination would not render Kranig et al. suitable as a low gloss coating composition. That is the case here. Jurgetz et al. does not provide any compositions expected to provide low gloss coatings. Accordingly, the combination of Kranig et al.

with Jurgetz et al. fails to present a “reasonable expectation of success” in meeting the low gloss features of the instant claims. See MPEP 2143.02.

Claim Rejections

Claims 1-6 and 8-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kranig et al. in view of Jurgetz et al.

The rejection at page 4, paragraph 7, admits that Kranig et al. fail to disclose the crystalline or semi-crystalline polycarboxylic acids or polyanhydrides, as instantly claimed, and fail to disclose a redox catalyst, as instantly claimed.

Jurgetz et al. disclose no unsaturated polyester, as is instantly claimed, and teach or suggest no powder coating composition for providing a low gloss surface finish, as is claimed. See the discussion of Jurgetz et al. in the Summary of Personal Interview with the Examiner, above.

The rejection states that it would have been prima facie obvious to use the crystalline or semi-crystalline polycarboxylic acids or polyanhydrides of Jurgetz et al. in Kranig et al.’s powder coating compositions to improve stability, flow, and appearance of the coating. However, the art provides no motivation to use the crystalline or semi-crystalline polycarboxylic acids or polyanhydrides of Jurgetz et al. in Kranig et al. It is well settled that the law requires some teaching or suggestion in the art to suggest the desirability of the combination of references to meet the claims. See In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000); In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir 1998); and MPEP 2143.01. Neither of Jurgetz et al. and Kranig et al. anywhere indicates that Kranig’s coating powders lack stability or need any improvement in flow or appearance to justify adding the crystalline or semi-crystalline polycarboxylic acids or polyanhydrides of Jurgetz et al. thereto. Accordingly, the art provides no motivation to add crystalline or semi-crystalline polycarboxylic acids or polyanhydrides, as is claimed, to the composition of Kranig et al.

In addition, each of Kranig et al. and Jurgetz et al. fails to suggest a composition for making a powder coating composition for providing a low gloss surface finish, as is claimed. Kranig et al. is silent with respect to gloss. Jurgetz et al. discloses only high gloss coatings while teaching that low gloss coatings are poor in performance. See Table

IV on columns 15 and 16, reporting a minimum 20° Gloss of 79 and stating that “higher numbers for gloss indicate better performance” (column 16, lines 30-32); see the discussion of Jurgetz et al. in the Summary of Personal Interview with the Examiner, above. In fact, the ordinary skilled artisan reading Kranig et al. and looking at Jurgetz et al. would only have been lead to make a high gloss coating.

In fact, Jurgetz et al. teaches away from a powder coating composition for providing a low gloss surface finish, as is claimed, stating that the crosslinkers used therein improve appearance and that high gloss indicates better performance.” Accordingly, the combination of Kranig et al. with Jurgetz et al. does not lead the ordinary skilled artisan to reasonably expect success in making a powder coating composition for providing a low gloss surface finish, as is claimed. See MPEP 2143.02; see also the discussion of “reasonable expectation of success” in the Summary of Personal Interview with the Examiner, above. Applicants therefore respectfully request the withdrawal of all rejections over Kranig et al. and Jurgetz et al., taken alone or in combination, and allowance of Claims 1-6 and 8-9.

Claims 7 and 10 stand rejected under 35 USC section 103(a) as obvious over Kranig et al. Jurgetz et al. and further in view of Muthiah et al. The Applicants respectfully traverse this rejection.

Muthiah et al. fail to teach any of the crystalline or semicrystalline carboxylic acid or anhydride, as is instantly claimed, or the glycidyl functional acrylic resin, as instantly claimed, or powder coating composition for providing a low gloss surface finish, as is claimed. Accordingly, Muthiah et al. does not remedy the deficiencies of the combination of Kranig et al. and Jurgetz et al.

Applicants therefore respectfully request the withdrawal of all rejections over Kranig et al., Jurgetz et al. and Muthiah et al., taken alone or in combination, and allowance of Claims 7 and 10.

April 29, 2004

CONCLUSION

The foregoing amendments and remarks place the instant claims in their proper format. An early and favorable entry of the instantly proposed amendment is earnestly solicited. If the Examiner has any questions or concerns, he is urged to contact the undersigned at the number given below.

If there are any additional charges with respect to this Preliminary Amendment or otherwise, please charge them to Deposit Account No. 18-1850.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew E.C. Merriam', written over a circular stamp or mark.

Andrew E.C. Merriam (Reg. No. 47,268)

ROHM and HAAS Company
100 Independence Mall West
Philadelphia, PA 19106
215-592-6758